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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,535	10/26/2001	Heather D. Boek	SP01-253	4706
20792	7590	02/23/2004	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC			HOFFMANN, JOHN M	
PO BOX 37428			ART UNIT	
RALEIGH, NC 27627			PAPER NUMBER	

1731

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/035,535

Applicant(s)

BOEK ET AL.

Examiner

John Hoffmann

Art Unit

1731

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-35.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: _____

John Hoffmann
Primary Examiner
Art Unit: 1731

2-17-04

Continuation of 2. NOTE: The new issue is if the change to claims 16 and 29 would make the claims allowable. And if not, it is unclear whether they are of matter which were ever rejected: in other words, would the claims require a new grounds of rejection.

Continuation of 5. does NOT place the application in condition for allowance because: the arguments were not persuasive. Applicant argues that Kyoto's discussion of using a high pressure treatment is not a disclosure of using a furnace that can create a high pressure. It is examiner's position that one cannot have a high pressure treatment without a device which can create a high pressure treatment. Regarding Ishikawa, Applicant argues that it teaches away from the present rejection - and that a careful reading supports such. Applicant's analysis of Ishikawa fails to address the Office's point that Ishikawa's pressure is a preferred embodiment and that one of ordinary skill immediately interprets this as not limiting the invention to the preferred embodiment. Rather, Applicant argues that one of ordinary skill would not step outside the bounds of the preferred embodiment. "it may still not be patentable if the modification was within the capabilities of one skilled in the art" In re Sola, 22 CPA (Patents) 1313, 77 F2d 627, 25 USPQ 433. Ishikawa's statements fail to state or imply that high pressure is not within the capabilities of one of ordinary skill. Complexity in doing something is simply that: complexity or difficulty - it does NOT suggest it is impossible - on the contrary it teaches IT CAN BE DONE, if one is willing to go through the extra effort and complexity. Difficulty does not equate with a "teaching away".